

REMARKS

Reconsideration of this Application is respectfully requested. Upon entry of the foregoing amendment, claims 1-4, 7-25, and 38-40 are pending in this application, with claims 1, 9 and 40 being the independent claims.

Allowable Subject Matter

Applicants appreciate the Examiner's indication of allowable subject matter in claim 19.

Interview

The undersigned appreciates the courtesies extended during the telephone interview conducted on April 7, 2004. During the interview, the independent claims and the Barnes patent were discussed. Applicants' representative and the Examiner discussed amending independent claims 1 and 9 to include a variation of the subject matter recited in claim 5.

The Claims are Allowable Over the Barnes Patent

Claims 1-5, 7-12, 15, 20, 22-25, 38 and 39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,038,488 to Barnes et al. ("the Barnes patent").

Independent claim 1 recites "an actuator configured to apply a haptic feedback to the elongated member based on the force signal, the haptic feedback operative to indicate when the distal portion of the elongated member has been translated to an end of a working channel that guides the elongated member."

Independent claim 9 recites "an actuator configured to apply a second force to the elongated member in the degree of freedom based on the force signal, the second force being operative to indicate when the distal portion of the elongated member has been translated to an end of a working channel that guides the elongated member."

As discussed during the interview conducted on April 7, 2004, claims 1 and 9 are allowable over the Barnes patent, as the Barnes patent fails to disclose or suggest "an actuator configured to apply a haptic feedback to the elongated member based on the force signal, the haptic feedback operative to indicate when the distal portion of the elongated member has been translated to an end of a working channel that guides the elongated member," as recited in

independent claim 1. Similarly, the Barnes patent fails to disclose or suggest “an actuator configured to apply a second force to the elongated member in the degree of freedom based on the force signal, the second force being operative to indicate when the distal portion of the elongated member has been translated to an end of a working channel that guides the elongated member,” as recited in independent claim 9.

Thus, independent claims 1 and 9 are allowable over the Barnes patent. Based at least on their dependence upon independent claims 1 and 9, dependent claims 2-4, 7-8, 10-12, 15, 20, 22-25, 38 and 39 are also allowable.

The Claims are Allowable over the Alexander and Marcus References

Claims 1-4, 7-18, 20-25, and 38 stand rejected under 35 U.S.C. § 103(a) as being obvious over PCT Publication No. WO 99/39317 to Alexander et al. (“Alexander”) in view of Marcus, “Touch Feedback in Surgery,” *Proceedings of Virtual Reality and Medicine, The Cutting Edge*, September 8-11, 1994, pp. 96-97 (“Marcus”).

As discussed above, independent claims 1 and 9 were amended to include the subject matter of claim 5. Accordingly, independent claims 1 and 9 are allowable over the combination of the Alexander and Marcus references. Based at least on their dependence upon independent claims 1 and 9, dependent claims 2-4, 7-8, 10-18, 20-25 and 38 are also allowable.

Claims 13 and 14 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over the Barnes patent. While not specifically addressed in the Office Action, Applicants submit that claims 13 and 14 are allowable based at least on their dependence upon independent claim 9.

New Claim

Applicants have added new claim 40, which includes the subject matter of claim 9 and allowable claim 19.

CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn. Applicants believe that a full and

complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that further personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Dated: April 13, 2004

Cooley Godward LLP
ATTN: Patent Group
One Freedom Square
Reston Town Center
11951 Freedom Drive
Reston, VA 20190-5656
Tel: (703) 456-8000
Fax: (703) 456-8100

Respectfully submitted,
COOLEY GODWARD LLP

By:



Erik B. Milch
Reg. No. 42,887